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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,199

12/08/2005

John A. Gelardi

21586

5532

48418

7590

08/07/2009

PARKS KNOWLTON LLC  
1117 PERIMETER CENTER WEST  
SUITE E402  
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EXAMINER

ALIE, GHASSEM

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

08/07/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/560,199

**Applicant(s)**

GELARDI, JOHN A.

**Examiner**

GHASSEM ALIE

**Art Unit**

3724

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-30 is/are pending in the application.
- 4a) Of the above claim(s) 20-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/14/09 has been entered, wherein claims 1-9 have been cancelled, claims 10-16 have been amended, and claims 17-30 have been added.

***Election/Restrictions***

2. Newly submitted claims 20-30 are directed to an invention that is independent or distinct from the invention that has been elected following reasons: the elected claim 16, on 09/18/08 in response to the restriction requirement mailed on 09/18/08, and new claims 20-30 are related as subcombinations disclosed as usable together in a single combination. It should be noted that claims 20-30 are related to the subject matter set forth in invention I (claims 1, 3-5, and 8-9) which have been not been elected and withdrawn from further consideration. See the restriction requirement mailed on 08/15/08 and the election submitted in the reply filed on 09/18/08.

- I. Claim 16, drawn to a seal cutting apparatus including a cutting member having at least a portion projecting away from the second surface and extending into a relief nick formed in the first surface.
- II. Claims 20-30, drawn to a combination including an abutment structure and a backstop structure.

Claim 10 link(s) inventions I and II. The restriction requirement among the linked inventions is **subject to** the nonallowance of the linking claim(s) 10. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312. Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, e.g., subcombination I has a separate utility such as it could be used without the abutment structure and the backstop structure, as set forth in invention II.

Conversely, subcombination II has a separate utility such as it could be used without the at least a portion projecting away from the second surface and extending into a relief nick formed in the first surface, as forth in invention I. See MPEP § 806.05(d).

It should be noted that the search for each individual invention may overlap but they do not coincide identically throughout. Therefore, the search for the elected invention may not be sufficient for the other non-elected inventions. Therefore, each individual invention includes a different field of search. In addition, the text and subclass search that might be needed to look for a particular feature in one invention is not sufficient for finding another particular feature in other invention due to their divergent subject matter. In other words, each individual invention with at least a distinct feature has a separate status in the art and requires a different field of search.

Since applicant has received an action on the merits for the claims that have been elected; accordingly, claims 20-30 are withdrawn from consideration as being directed to a non-elected invention. *See 37 CFR 1.142(b) and MPEP § 821.03.*

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 10, “the container” lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 10, 17 and 19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Winston (3,380,159). Regarding claim 10, Winston teaches a combination including a seal-cutting apparatus 10 including a receiving channel, the channel being at partially defined by an edge of a substantially planar first surface and a substantially planar second surface 24a, which includes the wall that receives the blade 21. It should be noted that the first surface is defined by the end portion of the runner 38 which is planar, as clearly shown in Fig. 6. The edge of the first surface is perpendicular to the planar second surface of the part 2sa that also holds the blade 21. Winston also teaches a cutting member 21 located at the second surface 24a and extending toward the first surface; and the seal-cutting apparatus 10 is held in a container 61 at an opening defined in the container. See Figs. 1-9 in Winston.

Regarding claims 17 and 19; Winston teaches everything noted above including that the opening of the container 61 is dimensioned such that the seal-cutting apparatus 10 is accessible through the opening; and the cutting member 21 projects from the second surface toward the edge of the first surface.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10 and 17-19, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleury (3,619,902) in view of Winston. Regarding claim 10, Fleury teaches a seal-cutting apparatus including a receiving channel 13, the channel being at partially defined by an edge of a substantially planar first surface 9a and a substantially planar second surface, defined by the wall of the handle 1 that is parallel to the cover 9 or blade 3. Fleury also teaches that the first surface is substantially perpendicular to the second surface. Fleury also teaches a cutting member 3 located at the second surface and extending toward the first surface. See Figs. 1-4 in Fleury. Fleury does not explicitly teach that the seal-cutting apparatus is held in a container at an opening defined in the container. However, the use of a package opener held in a container is well known in the art such as taught by Winston. Winston teaches a seal-cutting apparatus 10 is held in a container 61 at an opening defined in the container. See Figs. 1-9 in Winston.

It would have been obvious to a person of ordinary skill in the art to provide Fleury's seal-cutting apparatus with the container, as taught by Winston, in order to store the seal-cutting apparatus.

Regarding claims 16 and 19, Fleury teaches everything noted above including that at least a portion 3a of the cutting member 3 projects away from the second surface and extends into a relief nick 18 formed at the first surface 9a; and the cutting member 21 projects from the second surface toward the edge of the first surface.

Regarding claim 17, Fleury, as modified by Winston, teaches everything noted above including that the opening of the container 61 is dimensioned such that the seal-cutting apparatus 10 is accessible through the opening.

Regarding claim 18, Fleury, as modified by Winston, teaches everything noted above except that the seal cutting apparatus including detents and the container includes slots. However, Official Notice is taken that the use of detents and slots for holding or securing a tool in a container is old and well known in the art.

10. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleury in view of Winston, as applied to claim 10, and in further view of applicant admitted prior art, AAPA, Fig. 1. Regarding claim 11, Fleury teaches, as modified by Winston, teaches everything noted above except that the combination includes a blister package. However, the use of a seal-cutting apparatus for cutting a blister package, as shown in Fig. 1 of the instant application, is well known in the art. The seal-cutting apparatus as taught by Fleury, in capable of cutting many packages including a blister package. It would have been obvious to a person of ordinary skill in the art to use Fleury's seal cutting apparatus to cut a blister package, as taught by AAPA, since Fleury's seal cutting apparatus is capable of cutting many different packages including a blister package.

Regarding claims 11-15, Fleury, as modified above, teaches everything noted above including that the first surface 9a is configured to slideably engage at least one blister of a blister package; the second surface is configured to slideably engage at least one blister of the blister package; the receiving channel is configured to allow insertion of at least one edge of a blister package; and when a blister package is engaged with the first and second surfaces



and translated through the receiving channel, at least a portion of the package seal is at least partially severed by the cutting member 3. It should be noted that the top edge of the second surface is capable of slideably engaging at least one blister.

***Response to Arguments***

11. Applicant's arguments with respect to claims 10-19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Ghassem Alie/  
Primary Examiner, Art Unit 3724

August 3, 2009